

Election/Restriction

In response to the Restriction Requirement, Applicants provisionally elect, with traverse, Group I, claims 1-7 and 10 as set forth in the Requirement. Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter in this application.

Remarks

Pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's restriction requirement and requests reconsideration therefore in view of the following remarks.

An Examiner's authority to require restriction or election is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.

35 U.S.C. § 121, first sentence (emphasis added). The implementing regulations of the Patent and Trademark Office include the mandate that restriction or election is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independence and distinctness, a restriction or election requirement is unauthorized. In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the election requirement.

The courts have recognized that it is in the public interest to permit applicant to claim several aspects of their invention together in one application, as the applicant has done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore describe in the manner required by

35 U.S.C. § 112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666 117 U.S.P.Q. 250, 256 (CCPA 1973). This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

As the sole justification for the restriction requirement, the Examiner states that the inventions “do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature for the product is disclosed in US Patent 4,104,513 to Pearce and therefore there is not claimed a general inventive concept.” Applicants respectfully disagree. The general inventive concept is found in the method claims, from which all the product claims depend. The Examiner asserts that the “product must be examined under US rules as only that which is a claimed characteristic to the product itself, not in a method of making the product.” Again, Applicants respectfully disagree in that the method claims include features of the products.

In any event, reliance on an asserted “special technical features” does not establish independence and distinctness. This standard has no statutory recognition as evidence of whether inventions are independent and distinct. Rather, it is instead an aid in examination.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant’s financial resources, a practice which arbitrarily imposes election or restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), applicant is required to conduct simultaneous prosecution, as here, requiring excessive filing costs or to otherwise compromise the term of related patent assets.

It is vital to all applicants that election or restriction requirements issue only with the

proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. § 121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that § 121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle GmbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288 U.S.P.Q. 837, 840 (Fed. Cir. 1986). In Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), the court held that § 121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these consideration indicate that the imposition of an election or restriction requirement with inadequate authority can lead to situations in which an applicant’s legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee’s right and to serve the public interest in the legitimacy of issued patents, Applicants respectfully urge the Examiner not to require restriction in cases such as the present application wherein various aspects in a unitary invention are claimed.

Conclusion

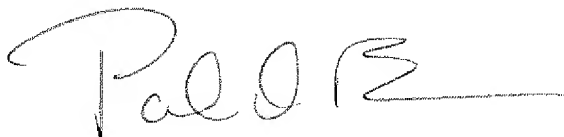
In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested.

If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Applicants: R. Waltham and A. Smith
Application No.: 10/088,811
Examiner: A. Bashore

No fee is believed to be due for this submission. However, please charge any additional fee required (or credit any overpayment) to the Deposit Account of the undersigned, Account No. 500601 (Docket No. 722-X02-022).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul D. Bianco". The signature is fluid and cursive, with a long horizontal stroke at the end.

Paul D. Bianco, Reg. #43,500

Customer Number: 27317
Paul D. Bianco
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO
21355 East Dixie Highway
Suite 115
Miami, Florida 33180
305-830-2600 (telephone) 305-830-2605 (facsimile)
e-mail: pbianco@fleitkain.com